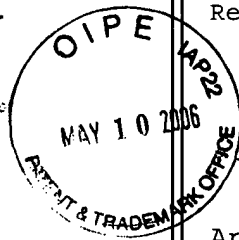


Appl. No. 10/081,000
Pre-Appeal Brief Request for Review dated May 3, 2006
Reply to Final Office Action of January 3, 2006



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Anatoli Fomenko

Assignee: Sun Microsystems, Inc.

Title: VERSIONING APPLICATION PROGRAMMING INTERFACE AND
METHOD FOR USING VERSIONING FUNCTIONALITY

Serial No.: 10/081,000 Filed: February 20, 2002

Examiner: Etienne P. LeRoux Group Art Unit: 2161

Docket No.: P-6507

Monterey, CA
May 3, 2006

Mail Stop AF
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated on the following sheets.

REMARKS

Claims 1 to 32 were pending in the application at the time of final examination. Claims 1 to 32 remain rejected as anticipated.

There are at least the following errors in the final rejection:

- 1) An improper claim interpretation was used that ignored the criteria in the MPEP and the holdings of the CAFC; and
- 2) A secondary reference was relied upon in the final rejection to interpret a term in the primary reference, but the secondary reference was not properly cited in the final action, and instead was provided only in the advisory action without a complete citation--no date or publisher. Applicant will argue the Office is barred from using the reference on appeal.

Claim 1 recites in part:

main interfaces defining versioning functionality, said main interfaces allowing access to the versioning functionality;

a functional implementation of said main interfaces, said functional implementation comprising classes and libraries implementing the versioning functionality, said classes including a reference to a program module to perform a requested versioning function;

(See Paper dated October 20, 2005 at page 2.)

The issue is the interpretation of "interfaces" in this portion of Claim 1. As cited in the paper dated October 20, 2005 at page 13, the Specification at Paragraph [0021] provided and explicit definition of "interface." Applicant at page 13 of the paper dated October 20, 2005 cited one of the MPEP criteria for Claim interpretation. The claim language is entirely consistent with the explicit definition given in the specification.

Nevertheless, an improper claim interpretation has been used for "interface" and the explicit requirements of the MPEP

have not been followed. The rejection argues since the claims are interpreted broadly, explicit claim limitations and definitions from the specification can be ignored, and that a dictionary definition that considers neither the claim limitations nor the environment of the invention as described in the specification can be used to interpret the claim limitation. See Final Office Action, dated January 3, 2006, page 10 and top of page 11.

As pointed out in the Response to the Final Office Action, dated March 3, 2006 at page 4, the MPEP provides a specific sequence of steps that are to be followed in claim interpretation and these steps clearly were not followed in the final rejection. Even after the definition in the specification was cited to the Examiner, a dictionary definition was used as justification for interpreting Aptus to read on Claim 1. This is clear error and is evidence that the above MPEP criteria were not followed.

While the Examiner is permitted to interpret the claims broadly, the MPEP and the courts put specific limitations on such an interpretation. In particular, as pointed out in the Response to the Final Office Action, dated March 3, 2006 at the last paragraph on page 4 and page 5, limitations are placed on when a dictionary definition can be used, and in the instant application, such use is inappropriate.

Determining the plain meaning of claim limitations is not reading limitations into the claims as alleged in the final rejection, but rather is complying with the statutory requirements as interpreted by the courts and the PTO. As pointed out in the Response to the Final Office Action, dated March 3, 2006 at last paragraph on page 5 and page 6, the MPEP elaborates on the criteria for determining the plain meaning of claim limitations.

Applicant has provided a clear definition of "interface" in the specification. The quotes from the MPEP demonstrate

that the analysis in the final rejection based on a contrary dictionary definition is not well founded and goes against the directive in the MPEP.

The MPEP further unequivocally stated the specification can be used to interpret claim language when a definition is provided as in the instant application. As pointed out in the Response to the Final Office Action, dated March 3, 2006 at the middle of page 6, the MPEP makes clear that such an interpretation is not reading limitations into the claims as stated in the final rejection. The MPEP directs that when there are several possible meanings, i.e., the one used in the dictionary and the one given in the specification, the disclosure serves to point away from the improper meaning, which in this case is the dictionary definition used to justify maintaining the anticipation rejection.

Also, as pointed out in the Response to the Final Office Action, dated March 3, 2006 at the top of page 7, a recent CAFC ruling, Philips v AWH Corp, 75 U.S.P.Q.2d 1321, 1334 (CAFC July 2005) reconfirms this point. The dictionary definition of "interface" used in the final rejection contradicts the explicit definition given in the specification and so fails to comply with the holding in the case.

If there is still any doubt as to how the claim interpretation is to be done when a definition is provided in the specification, the MPEP gives a concise statement:

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2106 C., 8th Ed. Rev. 3, p 2100-8 (August 2005). (See Response to the Final Office Action, dated March 3, 2006 at page 7)

Despite the unequivocal statements in the MPEP, the advisory action maintained the rejection based on the dictionary definition and attempted to backfill the improper

use of a reference that still was not properly cited. When the proper claim interpretation is used, Applicant's remarks in the final and prior responses to the office actions are persuasive and the application is in condition for allowance. Without the use of the improper dictionary definition, there is no basis for the rejection. Accordingly, Applicant respectfully requests allowance of all pending claims and an early issuance of a notice of allowance.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on May 3, 2006.



Attorney for Applicant(s)

May 3, 2006

Date of Signature

Respectfully submitted,



Forrest Gunnison
Attorney for Applicant(s)
Reg. No. 32,899
Tel.: (831) 655-0880